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cont.

wherein the adhesive mass is supported on a backing, and
wherein the local anesthetic is at least one selected from the group consisting of
lidocaine, procaine, oxyprocaine, dibucaine, bupivacaine, mepivacaine, and propitocaine.

REMARKS

Claims 1-5, 7 and 10-19 are active in the present application. Claim 6 has been cancelled. Claim 1 has been amended to include the limitations of Claim 6. No new matter has been added.

REQUEST FOR RECONSIDERATION

The present application is a National Stage Application of International Application No. PCT/JP99/04905 filed on September 9, 1999. The International Application claims priority to Japanese Application No. 28-2197/1998 filed on October 5, 1998. The effective U.S. filing date of a PCT application filed under 35 U.S.C. § 371 is the filing date of the PCT application (M.P.E.P. § 1895). Therefore the effective U.S. filing date of the above-identified application is September 9, 1999. Applicants submit concurrently herewith a certified English translation of the priority document. Applicants have thereby perfected their claim to priority and antedated the Kawaji reference (U.S. 6,177,098) and overcome the rejection under 35 U.S.C. § 103(a).

Claims 1-5, 1-14 and 16-17 were rejected under 35 U.S.C. § 103(a) in view of a patent to Chono (U.S. 6,139,866). Claim 1 has been amended to include the limitations of Claim 6. Claim 1 is now drawn to a tape preparation wherein the local anesthetic may be one of lidocaine, procaine, oxyprocaine, dibucaine, tetracaine, bupivacaine, mepivacaine, and/or propitocaine. Applicants submit that none of the local anesthetics provided in the Markush group of amended Claim 1 is disclosed in the Chono reference. Amended Claim 1 cannot be

obvious in view of Chono since Chono does not disclose or suggest the presently claimed local anesthetics.

Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a).

Applicants submit concurrently herewith an Information Disclosure Statement providing additional references for consideration in the above-identified application. Applicants respectfully request the Office provide a signed and initialed copy of the form PTO-1449 with the next communication from the Office to indicate that all references having been considered in the examination of the present application.

Applicants submitted an Information Disclosure Statement containing two references provided on a form PTO-1449 on June 4, 2001¹. The references provided on the PTO-1449 were those references provided in an International Search Report in the corresponding International Application. Form PCT/DO/EO/903 dated April 23, 2001, indicates that a copy of the International Search Report and copies of the references cited thereon were received by the Office. In the Office Action of February 20, 2003, the Office asserted that the IDS failed to comply with 37 C.F.R. § 1.98(a)(2) and the references thereon were not considered. Applicants submit that the IDS was timely filed on June 4, 2001 and that copies of the references were received by the Office as indicated in the form PCT/DO/EO/903 dated April 23, 2001. Applicants respectfully request the Examiner return a signed and initialed copy of the form PTO-1449 with the next communication from the Office. Copies of the form PTO-1449 and a date-stamped filing receipt evidencing the timely submission thereof are attached for the Examiner's convenience.

¹ Applicants requested that the Office return a signed and initialed copy of the form PTO in the Amendment and Request for Reconsideration filed with the Office on November 19, 2002 (see page 6).

Applicants submit the amendment to the claims places all now-pending claims in condition for allowance. Applicants respectfully request the withdrawal of the rejections and the passage of all now-pending claims to issue.

Respectfully submitted,

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Marked-Up Copy
Serial No: 09/786,370
Amendment Filed on: HEREWITH

IN THE CLAIMS

Please amend the claims as shown in the marked-up copy following this amendment to read as follows.

1. (Twice Amended) A tape preparation comprising an adhesive mass comprising 1-30 parts by weight of a local anesthetic in a base form in 100 parts by weight of a nonaqueous adhesive mass base comprising 5-50% by weight of a styrene-isoprene-styrene block copolymer, 1-60% by weight of an alicyclic saturated hydrocarbon resin, 5-60% by weight of liquid paraffin and 1-30% by weight of butyl rubber,

wherein the adhesive mass is supported on a backing, and

wherein the local anesthetic is at least one selected from the group consisting of lidocaine, procaine, oxyprocaine, dibucaine, bupivacaine, mepivacaine, and propitocaine.

6. (Canceled).